

REMARKS

Claims 1-17 are pending in this application. No further amendments to the claims are made herein. Claims 5-9 and 11-17 have been withdrawn from consideration. Accordingly, claims 1-4 and 10 are before the Examiner.

Priority

Applicants note with appreciation the acknowledgement of their priority claim.

Restriction/Election of Species

Applicants hereby affirm the election of Group I, claims 1-4 and 10 and substituted diazabicyclo[3.2.1]oct-4-ylpropanone, diazabicyclo[3.2.1]oct-4-ylpropenone, or diazabicyclo[3.2.1]oct-4-ylpropynone of formula I, p. 12, example 2.

Applicants note with appreciation the indication that the elected species is free of the prior art, and that examination has been expanded to include the relevant genus of Group I.

Claim rejections 112

Claims 1 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement, where E is $-c(R^1)_2-C(R^1)_2-$; and R^1 is not H, halogen, or C_1-C_4 alkyl. Applicants respectfully note that, as claimed, R^1 is not simply “not H, halogen, or C_1-C_4 alkyl”. Rather, in accordance with claim 1, R^1 is “independently selected at each occurrence from hydrogen, halogen, $-C_1-C_4$ alkyl, aryl, heteroaryl, $-C(O)R^4$, $-C(O)NHR^4$, $-CO_2R^4$ or $-SO_2R^4$.” Thus, the specification need not be enabling for any R^1 substituent that is not H, halogen or C_1-C_4 alkyl, but rather only for the much smaller list of substituents set forth in the claim. The burden to establish lack of enablement is upon the Office. (see MPEP 2164.04, “the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d

1510, 1513 (Fed. Cir. 1993).”) The Office has provided no reason to question the specification’s disclosure with respect to compounds within the scope of the claim, rather than the much broader discussion offered in the rejection. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 1-4 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement for the claimed in vivo hydrolysable precursors. Although applicants do not necessarily agree, the term has been deleted to advance prosecution. Withdrawal of the rejection is respectfully requested.

Applicants respectfully assert that the claims now satisfy all requirements of 35 U.S.C. § 112.

35 U.S.C. § 103

Claims 1, 2, and 10 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent 5,679,673 in view of Patani et al.

The rejection notes several differences between the ‘673 patent and the claimed invention. Notably, the ‘673 patent discloses a) diazabicyclo[3.2.2]nonanes rather than the claimed diazabicyclo[3.2.1]octanes, b) ethanones rather than the claimed propanones, and c) –Ph substituted with two –Cl atoms rather than the claimed Ph substituted with two –CH₃ groups.

The Office cites MPEP 2144.09 apparently for the proposition that the difference of a –CH₂– group in each of the diazabicyclo moiety and in the alkanone moiety results in a homolog expected to have similar properties.

The Office combines Patani et al. to support the allegation that Cl and CH₃ are interchangeable.

Although one of these differences might lead to the conclusion that the compounds are homologs, the combination of three such changes is certainly less clear. There simply is no suggestion in the cited references or the rejection itself that would lead one of skill in the art to

modify the teachings of the '673 patent to produce a compound that is a diazabicyclooctane, rather than diazabicyclononane, no further direction to chose a diazabicyclo[3.2.1]octane, no direction to chose a propanone linking group rather than an ethanone linking group, and no direction to chose an alkyl substituent rather than chloro. Certainly, there is no teaching, suggestion or motivation to make each of these modifications. Such direction comes only from Applicants own specification.

Furthermore, although, it might be possible that a compound reflecting one of these changes might be expected to have similar properties, the Office has provided no evidence or reasoning that would lead one of skill in the art to a reasonable expectation of success for modifying the cited reference in such ways. Accordingly, the rejection should be withdrawn.

Applicants respectfully request that the rejection based on 35 U.S.C. § 103 be withdrawn.

The Commissioner is hereby authorized to charge any fee or underpayment thereof or credit any overpayment to deposit account no. 26-0166.

Early reconsideration and allowance of all pending claims is respectfully requested. The examiner is requested to contact the undersigned attorney if an interview, telephonic or personal, would facilitate allowance of the claims.

Respectfully submitted,
AstraZeneca

Michael A. Patané

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by: /Michael A. Patané/
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